



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

MF
09/029,688

03/03/98

MADEMANN

F

P98.0162

EXAMINER

WM01/0103

HILL STEADMAN & SIMPSON
85TH FLOOR SEARS TOWER
CHICAGO IL 60606

SOBUTKA, P

ART UNIT

PAPER NUMBER

2683

DATE MAILED:

01/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

NW

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	14

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

See Attached

Interview Summary

Application No.

09/029,688

Applicant(s)

MADEMANN, FRANK

Examiner

Philip J. Sobutka

Art Unit

2683

All participants (applicant, applicant's representative, PTO personnel):

(1) Philip J. Sobutka.

(3) _____

(2) Mark Bergner.

(4) _____

Date of Interview: 28 December 2000 .

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description:

Claim(s) discussed: 1 .

Identification of prior art discussed: Boudreau .

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: discussed possible amendments to overcome boudreau. The examiner agreed that an amendment limiting the claims to a simplified paging list construction would appear to distinguish over Boudreau's more complex paging area construction.
Note that Mr. Bergner's faxed discussion points have been attached to the file.

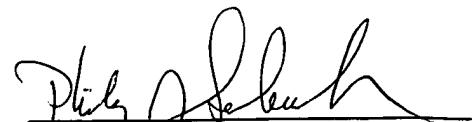
(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

**William G. Trost***Supervisory* **Primary Examiner**

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Schiff Hardin & Waite

PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, ILLINOIS 60606 USA
TELEPHONE: 312-258-5779
TELEFAX PATENT DEPARTMENT: 312-258-5921

TELEFAX COVER SHEET

TO: EXAMINER P. Sobutka Fax # 1(703) 308-6296

FROM: Attorney Mark Bergner
E-Mail address: mbergner@schiffhardin.com

DATE: December 19, 2000

SUBJECT: Informal Telephone Interview Discussion Points

CONFIDENTIALITY NOTICE

THIS FAX TRANSMISSION CONSISTS OF CONFIDENTIAL AND/OR ATTORNEY CLIENT PRIVILEGED AND/OR ATTORNEY WORK PRODUCT INFORMATION, AND IS INTENDED FOR THE ADDRESSEE ONLY. IF YOU RECEIVE THIS FAX IN ERROR, PLEASE CONTACT **Schiff Hardin & Waite** BY COLLECT TELEPHONE CALL TO ARRANGE FOR THE RETURN OF THIS MATERIAL. ANY USE OF THIS MATERIAL BY ANYONE OTHER THAN THE ADDRESSEE IS STRICTLY PROHIBITED.

Frank Mademann P98,0162 09/029,688 March 3, 1998

Method and System for Paging a Radiotelephone Unit Based on the Units Current Location (As Amended)

TOTAL NUMBER OF PAGES INCLUDING COVER SHEET: 3

-1-

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INFORMAL
TELEPHONE INTERVIEW DISCUSSION POINTS

5
APPLICANT: FRANK MADEMANN ATTORNEY DOCKET NO: P98,0162
SERIAL NUMBER: 09/029,688 GROUP ART UNIT: 2746
FILED: MARCH 3, 1998 EXAMINER: P. Sobutka
TITLE: METHOD AND SYSTEM FOR PAGING A RADIOTELEPHONE UNIT
BASED ON THE UNITS CURRENT LOCATION (AS AMENDED)

10
Examiner Philip Sobutka,
Washington, D.C. 20231

Dear Examiner Sobutka:

15
Thank you very much for agreeing to a telephone interview in the above identified case on
December 20, 2000 at 10:00 EST, which is currently under a final rejection based on the Office Action,
Paper 13, (OA) dated October 12, 2000.

We understand that you have added the Boudreau reference in combination with references
20 previously cited to provide a teaching of retaining previous cell identifiers that you noted was lacking in
Kauppi (OA, p. 2.). While we do not disagree with your characterization of Boudreau as being art whose
teaching requires consideration with respect to the present invention, we believe the present invention can
still be distinguished from the combination of references, including Boudreau, for reasons discussed below,
and ask that you briefly review this discussion prior to our interview.

25
You noted (OA, p. 2) that Boudreau teaches a registration process that retains the previous cell
identifiers in order to optimize the paging areas (noting especially Boudreau at 9/4-11).

Present invention's list construction—Please note that both independent claims 1 (method) and 10
(system), both of which are twice amended (in Amendment B), require a list of cell identifiers that are
constructed in a specific manner, i.e., that a transmitted cell identifier is entered into the list, and that this
30 transmitted cell identifier as well as all of those cell identifiers previously transmitted, become the list of
retained cell identifiers. This list of cell identifiers is then used to transmit the paging broadcast. A teaching

-2-

of such a construction is not found in Boudreau.

Boudreau's list construction—Boudreau simply records the cell identifier for statistical purposes (9/4-11 & 9/35-38). Boudreau then generates a plurality of location areas based on a statistical analysis and derives the list from specified paging area parameters (9/24-26) based on a statistical likelihood of the mobile station being found (10/1-9 & 10/30-34). This statistical information takes into account factors such as idiosyncracies of the geographic terrain and obstructions of a system (10/20-25). We note that there are many different ways such a statistical-based list could be constructed, including the above mentioned utilization of terrain factors, distances relating to a home base area or a last used area, some form of a most historical likely location, etc.—Boudreau is silent on the mechanisms of its list construction.

To summarize, Boudreau in no way discloses utilizing the list of retained cell identifiers as does the present invention, but rather utilizes a list based on a statistical formula based on parameters. We recognize our arguments present a narrow construction of the present invention, but we believe that the specific language used in the claims permits this narrow construction, and that this mechanism used by the present invention is not obviated by the addition of Boudreau.

We welcome any suggestions you might consider for claim language that could emphasize this distinction should you deem it necessary.

I believe the above conveys the main point that I would like to discuss. Again, thank you for your time and consideration.

Sincerely,

(Reg. No. 45,877)

Mark Bergner
Schiff Hardin & Waite
6600 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6473
(312) 258-5779
Attorneys for Applicant